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REMARKS

Claims 1 and 3-20 are pending in the present application. In view of the following

remarks, favorable reconsideration of this case is respectfully requested.

Claims 1, 3-15 and 17-20 are rejected under 35 U.S.C. 102(b) as being anticipated by

United States Patent No. 5,892,900 to Ginter et al. (hereafter Ginter). Claim 16 is rejected under

35 U.S.C. 103(a) as being unpatentable over Ginter. Applicants respectfully traverse.

In independent claim 1, for example, Applicants disclose:

A method executed in a computer system for monitoring a utilization condition of
contents, wherein said computer system is provided on a network to which a user
terminal is allowed to connect, said user terminal carrying out information
processing by utilizing said contents, comprising the steps of:

equipping information gathering means on the network;

registering authentication information on a database;

*embedding digital information in said contents, said digital information causing
said user terminal to automatically transmit a contents utilizing history
indicating a utilizing condition of the contents to said information gathering
means at a predetermined timing;*

distributing said contents to said user terminal, wherein said user terminal
includes a memory medium in which authentication information identical to said
registered authentication information is included, and wherein said terminal is
authenticated by said authentication information in the memory medium;

*gathering, according to the digital information included in the distributed
contents, said contents utilizing history via said information gathering means
which is automatically transmitted from the user terminal;*

recording the gathered contents utilizing history, in correspondence with said
registered authentication information, in the database; and

creating utilizing information indicating how much the particular content is
utilized, based on recorded data in the database.

(Emphasis added).

Ginter discloses a method and system for secure transaction management and electronic

rights protection (see, e.g., abstract of Ginter). The system of Ginter includes means for

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monitoring usage of distributed content (see, e.g., description of "usage metering" at column 17, line 42 to column 18, line 5 of Ginter).

According to the method of Ginter, a virtual distribution environment (VDE) is installed on each physical device to which content is distributed (see, e.g., column 15, lines 10 – 34 of Ginter). This VDE "core" is responsible for providing content management functions such as usage auditing. In sharp contrast to the method of Ginter, Applicants' claimed method provides a means for *embedding digital information* within the distributed digital contents that is *effective to cause a contents utilizing history to be prepared and transmitted by a user terminal receiving distributed contents* (see, e.g., page 18, line 27 – page 19, line 30 of Applicants' specification). Applicants' claimed method based on embedded digital information ("middleware") enables content usage monitoring to be performed by a variety of user terminal platforms, without requiring the installation of a specific content management software as in the case of Ginter. Accordingly, Applicants respectfully submit that the method as taught in amended independent claim 1 is not anticipated by Ginter, and that amended independent claim 1 is therefore allowable.

The Examiner's response to the argument presented above maintains that Ginter discloses the feature of "embedding digital information in said contents," (Office Action; page 8, lines 14-16), citing Ginter. The cited section states, in its entirety, "[o]f course, VDE 100 containers can also be stored with all required control structures and content *together*." (Ginter; col. 134, line 67 to col. 135, line 1; emphasis added). It is respectfully submitted that the cited section does not disclose the VDE container being *embedded in* digital content, and merely discusses the VDE container being stored *together* with content. The meaning of "embed" is "to enclose snugly or firmly," "to cause to be an integral part of a surrounding whole" (The American Heritage®

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Dictionary of the English Language, Fourth Edition), "to enclose closely in or as if in a matrix," and/or "to make something an integral part of" (Merriam-Webster Online Dictionary). None of these definitions would support the VDE container being stored *together with* content as anticipating *embedding* digital information which monitors the utilization condition of digital contents *within* the digital contents, as recited in claim 1. The discussion of storing the VDE container together with content simply does not anticipate embedding digital information in digital contents. Therefore, for at least this reason, claim 1 is allowable.

Additionally, the disclosure of Ginter does not appear to disclose or suggest "said digital information causing said user terminal to *automatically transmit* a contents utilizing history indicating a utilizing condition of the contents to said information gathering means *at a predetermined timing*", or "gathering, according to the digital information included in the distributed contents, said contents utilizing history via said information gathering means which is *automatically transmitted* from the user terminal", as recited in claim 1. The Examiner relies on several disclosures in Ginter relating to reporting usage information from a user clearinghouse. (Ginter; col. 18, lines 22-24; col. 33, lines 36-38; col. 36, lines 28-34; and col. 137, lines 7-10). These sections apparently relate to the metering of usage information of electronic content. However, none of the cited sections appear to disclose embedded digital information causing a user terminal to *automatically transmit a contents utilizing history*, as recited in the independent claims. The Office Action cites several additional sections of Ginter in support of the gathering step of claim 1, which includes the automatic transmission from the user terminal of contents utilizing history. However, none of these sections discuss or even suggest digital contents including digital information causing a user terminal to automatically transmit information to another system. For instance, flexible metering is apparently discussed (Ginter; col. 33, lines 36-

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65); updating a secure database is apparently discussed (Ginter; col. 168, lines 1-15); and storing

an audit record is apparently discussed (Ginter; col. 188, lines 29-38). One section cited by the

Examiner states:

> "System-initiated" events are generally happenings not attributable
> to a user. Examples of system initiated events include the
> *expiration of a timer* indicating that information should be backed
> to non-volatile memory, *receipt of a message* from another
> electronic appliance 600, and *a service call generated* by another
> process (which may have been started to respond to a system-
> initiated event and/or a user-initiated event).

(Ginter; col. 176, lines 58-65; emphasis added). However, none of the system initiated events

discussed in the quoted section of Ginter relate to *updating with contents utilizing history an*

information gathering means. Therefore Ginter does not disclose or suggest this feature, and

claim 1 is allowable at least for this additional reason.

As independent claims 6, 11, 13, 15, and 17 each include limitations providing for the

generation of a contents utilizing history at a user terminal based by means of information

embedded in the digital content distributed to the user terminal, and include limitations providing

for gathering, according to digital information included in distributed contents, a contents

utilizing history via an information gathering means which is automatically transmitted from the

user terminal, Applicants reapply the above arguments in regard to claims 6, 11, 13, 15, and 17,

and submit that claims 6, 11, 13, 15, and 17 are also allowable. As claims 3-5, 7-10, 12, 14, 16,

and 18-20 each depend from one of allowable independents claims 1, 6, 11, 13, 15 and 17,

Applicants respectfully submit that claims 3-5, 7-10, 12, 14, 16, and 18-20 are allowable for at
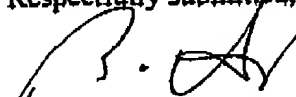
least this reason.

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CONCLUSION

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,

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